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11/21/07

In re Application of:

Toth, Thomas L., et al.

Serial No. 10/063,420

Filed: April 22, 2002

Docket: GEMS8081.115

Title:

METHOD AND APPARATUS OF
MODULATING RADIATION
FILTERING DURING
RADIOGRAPHIC IMAGING

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed May 11, 2007 petitioning the Technology Center Director under 37 CFR § 1.181 for supervisory review of the requirement under 37 CFR § 1.105 and alleged improper use of the Notice of Non-Compliant Amendment. No fee is due.

The petition is dismissed.

Background

The Examiner assigned to the application mailed a 37 CFR § 1.105 requirement to Applicants on June 07, 2006 requiring Applicants to disclose all co-pending applications and related patents to the application being examined and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. Examiner cited no less than eight applications and eight patents that Examiner is presently aware of and believes may be related and have overlapping subject matter. Examiner makes the requirement on the basis that Applicants or the assignee are presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which comparisons could be done better than within the Office for the Examiner to thereby determine the commonality among the claims by this information.

Applicants responded on September 7, 2006 with a response regarding MPEP 704.11(a)(G) stating that:

...information required for examination may include "identification of pending or abandoned applications filed by at least one of the inventors or assigned to the same

assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application." MPEP 704.11(a)(G).

"704.11(a) does not authorize an examiner to require an applicant to identify specific claims in those related applications and/or patents." Applicant respectfully believes that such a requirement shifts the examiner's responsibilities to the applicant.

On December 11, 2006, in response, Examiner mailed a Notice of Non-Compliant Amendment under 37 CFR 1.121, stating that Applicants had failed to provide a listing of claims relevant to the possible double patenting issue. While the Notice sets forth one month to respond, Examiner sets forth two months on Page of the accompanying attachment.

Applicants responded on January 11, 2007 with a response focusing on 37 CFR 1.121, stating,

No amendments were made in the response of September 7, 2006, and as such, the Examiner has provided no grounds for the issuance of a Notice of Non-Compliance under 37 CFR 1.121.

On April 11, 2007, Examiner mailed another Notice of Non-Compliant Amendment under 37 CFR 1.121. Examiner added, "The time period for response will continue to run from the mail date of the previous office action." That is, it continues to run from the first notice of Non-Compliant Amendment mailed December 11, 2006.

Applicants submit that Examiner's use of a Notice of Non-Compliant Amendment under 37 CFR 1.121 was improper because the reasons for such notice departed from the substance of 37 CFR 1.121. In addition, Applicant submits that Examiner's requirement for a listing of claims relevant to the possible double patenting issue is beyond the scope 37 CFR § 1.105. Applicants state that Examiner is requiring more than facts or factual information as intended by 37 CFR § 1.105, but is instead requiring an opinion by requiring an evaluation of the claims of any of the listed and to be listed applications and patents that may be related with respect to statutory or obviousness-type double patenting.

Discussion

With respect to Applicants' claim that a Notice of Non-Compliant Amendment under 37 CFR 1.121 was improper, MPEP 704.12(c) states, in part,

An incomplete reply to a 37 CFR 1.105 requirement in a pending application or reexamination proceeding is handled in the same manner as an amendment not fully responsive to a non-final Office action.

In the instant case, Applicants' September 7, 2006 response to Examiner's 37 CFR 1.105 Requirement failed to provide a listing of claims relevant to the possible double patenting issue. Thus, Applicants' response was an incomplete reply and Examiner was required to issue a Notice of Non-Compliant Amendment under 37 CFR 1.121.

With respect to Applicants' claim that Examiner's requirement for a listing of claims relevant to the possible double patenting issue is beyond the scope of 37 CFR § 1.105, M.P.E.P. 704.11 states, in part,

The terms "factual" and "facts" are included in 37 CFR § 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR § 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant...

The purpose of 37 CFR § 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information."

From a recent Federal Circuit decision:

Scope of information that may be required from applicant by patent examiner pursuant to 37 C.F.R. §1.105 encompasses information relevant to patent examination either procedurally or substantively, and includes zone of information beyond that defined by 37 C.F.R. §1.56 as material to patentability, and beyond that which is directly useful to support rejection or conclusively decide issue of patentability, since Section 1.105(a)(1) states that PTO may "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter" [...] *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Duty of candor embodied in 37 C.F.R. §1.56 does not give patent applicant power to refuse requirement for information under 37 C.F.R. §1.105, since neither regulation states that response to such requirement may be limited, at applicant's discretion, to whatever applicant believes it might be affirmatively required to submit under Section 1.56, since language in Section 1.105(a)(1), which permits PTO to "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter," expressly states that PTO, not applicant, controls scope of requirement for information, and since scope of information that may be required under Section 1.105 is broader than information that applicant is duty bound to provide under Section 1.56, *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

United States Patent and Trademark Office can use requirement for information under 37 C.F.R. §1.105 to compel disclosure of information that patent examiner deems pertinent to patentability, even if applicant disagrees with examiner concerning significance of information to ultimate question of whether application discloses patentable subject matter, since PTO is clearly entitled to use Section 1.105 to seek information that may support rejection, and since examiner is charged with duty of deciding whether patent should issue from application, and so long as examiner's request for information is not arbitrary or capricious, applicant cannot impede examiner's performance of that duty by refusing to comply with information requirement that proceeds from examiner's view of scope of law to be applied to application. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

If an applicant were required to make an admission that the claims of one application or patent read on the claims of another, it would appear that this would be beyond the scope of 37 CFR § 1.105. However, in the present situation, Applicants are not being asked this but to identify claims that *may* present double patenting issues. Applicants would be making comparisons to identify similarities in the claims. This is not an admission that the claims conflict. Examiner still will determine this. Applicants would be identifying observed facts and then Examiner would render an opinion from these facts. Thus, an opinion from Applicants is not being required.

Nevertheless, it appears that the Court considers forms of opinion relevant and within the authority of the Examiner to require.

...Other requirements for information are also foreseeable under the "reasonably necessary to properly examine or treat the matter" standard. For instance, it might be reasonably necessary for the Office to require an explanation of technical material in a publication, such as one of the

inventor's publications, or require the applicant's *comments* on a recent Federal Circuit opinion and how that opinion affects examination. ... The final rule permits that "the examiner or other Office employee may *require the submission* ... of such information as may be reasonably necessary to properly examine or treat the matter." 37 C.F.R. 1.105(a)(1) [emphasis added] *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Through notice and comment rulemaking the Office made explicit the inherent authority of Office employees to require information from an applicant. The goal is to "encourage" employees to use that power to "perform the best quality examination possible." *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Opinion is clearly permitted to the extent it may define viable information. This is not different from an applicant citing a reference for consideration before the examiner, as this is an opinion as to what is believed material to patentability under 37 CFR § 1.56. The examiner considers that reference and ultimately determines whether that reference is to be applied against the claims. When the examiner requires a submission of information under 37 CFR § 1.105 that may be material to patentability, the examiner is still making the ultimate decision based on the submission whether that material is applicable. The examiner has required this information because it "improve[s] patent quality, and render[s] better decisions" (MPEP 704.11).

Thus, according to M.P.E.P. 704.11 and the Federal Circuit Court, Examiner's requirement for a listing of claims relevant to the possible double patenting issue is within the scope of 37 CFR § 1.105. The listing requirement is further supported by the Court's implications that forms of opinion may be relevant and within the authority of the Examiner to require if it is providing material information..

With respect to Applicants' stating that there was no non-compliance under 37 CFR 1.121, M.P.E.P. 714.03 states, in part:

Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) **if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied. [Emphasis added]**

37 CFR 1.135(c) "Abandonment for Failure to Reply Within Time Period," states:

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, **applicant may be given a new time period for reply under § 1.134 to supply the omission. [Emphasis added]**

37 CFR 1.134, "Time Period for Reply to an Office action," states:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

In the instant case, Applicants filed a response to Examiner's June 7, 2006 37 CFR § 1.105 Requirement on September 7, 2006, three months later. Because Applicant did attempt a reply within three months, while reply was incomplete, Examiner set forth a one month response

period in compliance with 37 CFR 1.121. Although Examiner set forth the one month period as applicable to the Non-Compliant Amendment Form under 37 CFR 1.121 instead of based on 37 CFR 1.135(c), the basis for providing the one month period is the same. (See M.P.E.P. 704.12(c), 714.03.)

While it is understandable that the examiner could have applied 37 CFR 1.135(c) instead of 37 CFR 1.121, a new period is set either way. Since Examiner set forth a two-month period on page 5 of the attachment, this is considered as superseding the set forth amount on said Notice on December 11, 2006.

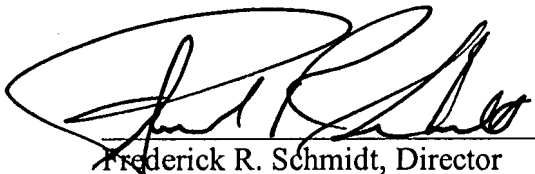
Applicants' second reply did not perfect the required response. Therefore, the response was no longer considered bona fide. In the second Notice of Non-Compliant Amendment, Examiner pointed out, "The time period for response will continue to run from the mail date of the previous Office action." Because the mail date of the previous Office action was December 11, 2006, and a maximum period of six months is allowed under 37 CFR 1.134, Applicants' application became abandoned one day after June 11, 2007 without the additional fees for four months extension of time and a complete response to the original 37 CFR 1.105 requirement.

Conclusion

Ultimately, the purpose in requiring applicants to identify claims in the identified and yet to be identified related applications and patents is to improve the quality of examination by the examiner with respect to statutory and obviousness-type double patenting particularly in view of the significant number of applications and patents involved. In view thereof, the examiner's requirement is not seen as unreasonable and is seen as within the scope of 37 CFR § 1.105.

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Program Examiner, at (571) 272-4514.



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